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PATENT
P56321

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

IN-SUNG CHOI

Serial No.: 09/898,088

Examiner: SIDDIQI, MOHAMMAD A.

Filed: 5 July 2001

Art Unit: 2154

For: SYSTEM AND METHOD FOR REAL-TIME DEVICE DRIVER ERROR
HANDLING

PETITION UNDER 37 C.F.R. §1.181

Mail Stop: Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant respectfully request reconsideration and withdrawal of the finality of the rejection of the last Office action (Paper No. 20041208) mailed on 4 January 2005, and as reasons therefore states that:

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Date: 3/4/05

I.D.: REB/SS/sb

STATEMENT OF FACTS

1. Applicant filed a patent application on 5 July 2001 setting forth claims 1-23.
2. The U.S. Patent and Trademark Office mailed a non-final Office action on 7 October 2003 (Paper No. 5). The Examiner rejected claims 1-23 under 35 U.S.C. § 102(e) as being anticipated by Cromer et al. (U.S. Patent No. 6,256,732).
3. Applicant filed an Amendment on 5 January 2004. Claim 1 was amended.
4. The U.S. Patent and Trademark Office mailed a non-final Office action on 13 May 2004 (Paper No. 9). Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jenkins et al. (U.S. Patent No. 6,002,868) in view of Philyaw et al. (U.S. Patent No. 6,704,864).
5. Applicant filed an Amendment on 6 August 2004. Claim 1 was amended, and claim 24 was newly added.
6. The U.S. Patent and Trademark Office mailed a final Office action on 4 January 2005 (Paper No. 20041208). Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jenkins et al. (U.S. Patent No. 6,002,868) in view of Philyaw et al. (U.S. Patent No. 6,704,864).

REMARKS

The Applicant respectfully believes that the final Office action mailed on 4 January 2005 (Paper No. 20041208) is a premature final Office action for the following reasons.

The Applicants respectfully believe that the final Office action mailed on 4 January 2005 (Paper No. 20041208) is a premature final Office action because in the previous response to paper number 9, the Applicant had asked the Examiner that further clarification by Examiner would be very helpful to the Applicant. Specifically and respectfully, the response stated that the Examiner must provide the completeness in the rejection under 37 C.F.R. §1.104(b) and (c) in formulating the rejection. As mentioned in 37CFR §1.104 (c)(2), "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." Concerning certain rejections, a string of passages were quoted without any particular reference to the particular parts being relied on. The particular parts relied upon were not mentioned and therefore it makes it difficult for the Applicant to respond to the Examiner's rejection. Quoting large portions of the text does not always take the place of showing the particular part especially when it is not entirely clear what particular parts are being referenced from the body of text quoted.

The particular parts relied upon were not always mentioned and therefore it makes it difficult for the Applicant to respond to the Examiner's rejection. As seen throughout the office action of the Examiner, only general portions of the specification were mentioned without differentiating what particular parts are being relied upon. For example pages of a reference such as col. 8, lines 26-53 and col. 4 lines 35-67 were stated for a particular part, but looking at over 50 lines of text it is

difficult to discern the particular part being relied upon.

The Applicant asked the Examiner in the previous office action response filed on 6 August 2004 to provide the particular part being relied upon, but the Examiner failed to provide such information in the office action of 4 January 2005 (paper no. 20041208) and now the Applicant asks again. Moreover since such clarification was not provided in paper no. 20041208, the finality of the rejection should be removed.

As mentioned in MPEP §706.07, “ Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”


The Applicant would greatly appreciate the Examiner’s cooperation on this regard in order to provide a full an fair hearing for the Applicant. Here, since the Examiner failed to provide the particular parts being relied upon, a clear issue has not been developed between the examiner and applicant according to MPEP §706.07.

RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

- A. Reconsider the finality of the rejection of the last Office action (Paper No. 20041208);
- B. Withdraw the finality of the last Office action (Paper No. 20041208);
- C. Require the Examiner to provide Applicant with clarification of the rejection in the last Office action (Paper No. 20041208); and
- D. Grant such other and further relief as justice may require.

Respectfully submitted,


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